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10/761,059	01/20/2004	Rodrigo Pastro	2003P02177 US	2006
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Siemens Corporation Intellectual Property Department 170 Wood Avenue South Iselin, NJ 08830			EXAMINER RICHARDSON, THOMAS W	
			ART UNIT 2444	PAPER NUMBER
			MAIL DATE 12/07/2010	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/761,059

**Applicant(s)**

PASTRO ET AL.

**Examiner**

THOMAS RICHARDSON

**Art Unit**

2444

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 October 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/CD)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Claims 1-46 are pending for examination.

Claims 1-46 are rejected.

#### ***Response to Arguments***

1. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

#### ***Claim Rejections - 35 USC § 103***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims rejected under 35 U.S.C. 103(a) as being unpatentable over US 2003/0021397, Wengrovitz, US 2009/0125591, Kirkpatrick, and US 6 714 793, Carey et al.
4. As per claim 1, Wengrovitz teaches an apparatus for performing instant messaging (IM) under a first protocol, said apparatus comprising:
- a first device implementing a first protocol (Figure 1, telephone 30);
  - a second device implementing a second protocol, wherein said first protocol and said second protocol comprise a telephony application protocol and a protocol supporting instant messaging in peer to peer services and at least one of said first device and said second device is a telephone set in one or more telephone sets in a private communications network, said telephone set implementing said telephony application protocol and having a keypad having a fixed number of key buttons and a display (Figure 1, PC 40, also paragraphs 22-23, where the second device may utilize

SIP, and the first may utilize PBX and CSTA protocols, also paragraph 46, where the conversion may be between PBX devices, known in the art to be utilized over a private network);

a protocol converter to convert messages between said first device and said second device to/from between said first protocol from/to said second protocol and IM capability between telephone sets in said private communications network (paragraph 23, where the message is translated for delivery to the telephonic device);

a register to register said first device and said second device (paragraphs 25-27, where the messaging server contains information regarding senders and recipients of messages and their extensions); and

a map to map a first client to said first device and a second client to said second device, said peer to peer services including Instant Messaging (IM) (paragraphs 25-27, where the messaging server contains information regarding senders and recipients of messages and their extensions).

Wengrovitz does not expressly teach the first and second protocols being incompatible. Kirkpatrick teaches an instant messaging proxy comprising:

a first device implementing a first protocol (paragraph 34, where the wireless device utilizes an IM protocol);

a second device implementing a second protocol, wherein messages in said first protocol are incompatible with said second protocol and messages in said second protocol are incompatible with said first protocol, and wherein said first protocol and said second protocol comprise a protocol supporting IM in peer to peer services (paragraph

34, where the service-specific protocols may be used with other IM services, also paragraph 32, where each instant messaging service uses a different, incompatible protocol);

a protocol converter to convert incompatible messages between said first device and said second device to/from said first protocol from/to said second protocol, said protocol converter providing IM capability to and managing IM capability for said telephone set (paragraphs 35 and 36, where the protocol conversion module may convert objects for messages between protocols for devices);

a register to register said first device and said second device (paragraph 10, where the IM connection information associated with a client may be utilized and stored to make a connection between devices);

a map to map a first client to said first device and said second client to said second device (paragraph 10, where the IM connection information associated with a client may be utilized and stored to make a connection between devices).

It would have been obvious to utilize a protocol conversion such as taught by Kirkpatrick in a communication system such as taught by Wengrovitz. Wengrovitz's system allows messages to be sent from a PC in one message format and received by a telephone in another format (abstract). It would be beneficial in such a system to utilize a protocol conversion with instant messaging such as that taught by Kirkpatrick, as the protocol conversion allows multiple device types to communicate with each other, and a user to send messages to another user regardless of the device types of the sending and receiving users (paragraph 14).

Neither Wengrovitz nor Kirkpatrick expressly teaches the telephone having full IM capability. Carey teaches a cellular instant messaging system comprising:

full IM capability is provided to said telephone set, full IM capability including creating a buddy list (column 4, lines 6-33, where the user may create an instant messaging name list).

It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize a telephone with full IM capabilities such as that taught by Carey in a telephone-based instant messaging system such as that taught by Wengrovitz or Kirkpatrick. Wengrovitz's system allows messages to be sent from a PC in one message format and received by a telephone in another format (abstract). Kirkpatrick's system allows for mobile devices including cellular phone to utilize instant messaging (Figure 1). It would be beneficial in such a system to utilize IM capabilities such as taught by Carey, as the telephone could utilize instant messaging to communicate with the PC-based client.

5. As per claim 2, Wengrovitz further teaches said first protocol is a Session Initiation Protocol (SIP), said first device is connected to a SIP server, said first device passing IM communications with other SIP devices through said SIP server and bypassing said protocol converter (paragraph 22, where SIP may be utilized, also paragraph 52, where SIP sets may operate in a peer to peer mode without a master controller).
6. As per claim 3, Wengrovitz further teaches said second protocol is a Computer Supported Telephony Application (CSTA) and said protocol converter converts between

CSTA and SIP/SIMPLE, IM messages between telephone sets passing through said protocol converter to said SIP server and returning through said protocol converter (paragraph 23, where the other device utilizes CSTA and PBX).

7. As per claim 4, Wengrovitz further teaches said first device is a SIP device exchanging SIP/SIMPLE messages with said protocol converter through said SIP server (paragraph 22, where SIP may be utilized by the PC client).

Wengrovitz does not expressly teach utilizing presence information. Carey teaches a cellular instant messaging system comprising:

managing and determining presence information for a respective IM user (column 5, lines 58-62, where the recipient is determined to be on or off-line).

8. As per claim 5, Wengrovitz further teaches said first device is a PC (Figure 1, PC 40).

9. As per claim 6, Carey further teaches said first device is a PDA (Figure 1, mobile units 36).

10. As per claim 7, Wengrovitz further teaches said second device is said telephone set; said telephone comprise a plurality of digital telephones, instant messaging being displayed on said display on said digital telephones (Figure 1, telephone 30, also paragraph 37, where IM messages may be displayed).

11. As per claim 8, Wengrovitz further teaches said digital telephones are connected through a telephonic switch (paragraph 31, where the PBX may be part of a PSTN).

12. As per claim 9, Wengrovitz further teaches said telephonic switch is a PBX connected to said protocol converter using CSTA protocol, said CSTA device

exchanging CSTA protocol messages with said protocol converter (paragraph 23, where the translator may translate from PBX and CSTA).

Wengrovitz does not expressly teach the telephone having full IM capability. Carey teaches a cellular instant messaging system comprising:

full IM capability is provided to said telephone set, full IM capability including composing, retrieving, and responding to messages (column 4, lines 6-33, where the user may create an instant messaging name list).

13. As per claim 10, Wengrovitz further teaches said first device is a CSTA device (paragraph 23, where CSTA may be utilized and translated).

14. As per claim 11, Wengrovitz further teaches said first device is a telephone set and said telephone set is a digital telephone, wherein at least one key button is a programmable key (Figure 1, telephone set 30, also paragraph 21, where the telephone may include a keypad and function buttons).

15. As per claim 12, Wengrovitz further teaches said digital telephone is connected through a telephonic switch monitoring said key buttons and having full control of said display (paragraph 21, where the telephone may have a display and be connected to a PBX, also paragraph 7, where the message may be displayed at the telephone).

16. As per claim 13, Wengrovitz further teaches said telephone switch is a PBX connected to said protocol converter using CSTA (paragraph 23, where the translator may translate from PBX and CSTA).

17. As per claim 14, Wengrovitz teaches a method for supporting Instant Messaging (IM) in digital telephones, comprising the steps of:



registering a first protocol digital telephone set including a display and a keypad having a fixed number of key buttons (Figure 1, telephone 30, also paragraph 21, where the telephone may include a keypad and function buttons);

converting messages from said first protocol digital telephone set in said first protocol to messages in a second protocol, wherein at said first protocol is a telephony application protocol and said second protocol supports peer to peer services including Instant Messaging (IM) (paragraphs 22-23, where the second device may utilize SIP, and the first may utilize PBX and CSTA protocols, and where a message is translated for delivery to the telephone);

mapping an IM identity of a client to said digital telephone set (paragraphs 25-27, where the messaging server contains information regarding senders and recipients of messages and their extensions); and

communicating an instant message in one or more converted messages to or from said digital telephone set, instant messaging being displayed on said display, wherein converted messages to or from other registered digital telephone sets are communicated through said internetworking unit through a first protocol server and back, wherein converted messages to or from other registered digital telephone sets are communicated through said internetworking unit through a first protocol server and back (paragraph 21, where the telephone may have a display and be connected to a PBX, also paragraph 7, where the message may be displayed at the telephone, also paragraph 53, where the converters translate between IP-PBX protocol and SIP protocol in either direction).

Wengrovitz does not expressly teach the first and second protocols being incompatible.

Kirkpatrick teaches an instant messaging proxy comprising:

a first device implementing a first protocol (paragraph 34, where the wireless device utilizes an IM protocol);

a second device implementing a second protocol, wherein messages in said first protocol are incompatible with said second protocol and messages in said second protocol are incompatible with said first protocol, and wherein said first protocol and said second protocol comprise a protocol supporting IM in peer to peer services (paragraph 34, where the service-specific protocols may be used with other IM services, also paragraph 32, where each instant messaging service uses a different, incompatible protocol);

a protocol converter to convert incompatible messages between said first device and said second device to/from said first protocol from/to said second protocol, said protocol converter providing IM capability to and managing IM capability for said telephone set (paragraphs 35 and 36, where the protocol conversion module may convert objects for messages between protocols for devices);

a register to register said first device and said second device (paragraph 10, where the IM connection information associated with a client may be utilized and stored to make a connection between devices);

a map to map a first client to said first device and said second client to said second device (paragraph 10, where the IM connection information associated with a client may be utilized and stored to make a connection between devices).

It would have been obvious to utilize a protocol conversion such as taught by Kirkpatrick in a communication system such as taught by Wengrovitz. Wengrovitz's system allows messages to be sent from a PC in one message format and received by a telephone in another format (abstract). It would be beneficial in such a system to utilize a protocol conversion with instant messaging such as that taught by Kirkpatrick, as the protocol conversion allows multiple device types to communicate with each other, and a user to send messages to another user regardless of the device types of the sending and receiving users (paragraph 14).

Neither Wengrovitz nor Kirkpatrick expressly teaches the telephone having full IM capability. Carey teaches a cellular instant messaging system comprising:

full IM capability is provided to said telephone set, full IM capability including creating a buddy list (column 4, lines 6-33, where the user may create an instant messaging name list).

It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize a telephone with full IM capabilities such as that taught by Carey in a telephone-based instant messaging system such as that taught by Wengrovitz or Kirkpatrick. Wengrovitz's system allows messages to be sent from a PC in one message format and received by a telephone in another format (abstract). Kirkpatrick's system allows for mobile devices including cellular phone to utilize instant messaging (Figure 1). It would be beneficial in such a system to utilize IM capabilities such as taught by Carey, as the telephone could utilize instant messaging to communicate with the PC-based client.

18. As per claim 15, Wengrovitz further teaches registering a second device; wherein said mapping step further maps an IM identity of a second client to said second device and said instant messaging includes communicating an instant message between said first digital telephone set and said second device (paragraphs 25-27, where the messaging server contains information regarding senders and recipients of messages and their extensions, also Figure 1, telephone 30, also paragraph 37, where IM messages may be displayed).

19. As per claim 16, Wengrovitz further teaches mapping a second client to said PC and said instant messaging includes communicating an instant message between said first digital telephone set and said PC (Figure 1, PC 40, also paragraphs 22-23, where the second device may utilize SIP, and the first may utilize PBX and CSTA protocols, and where a message is translated for delivery to the telephone).

20. As per claim 17, Wengrovitz further teaches said second device is a Computer Supported Telephony Application (CSTA) digital telephone set; and wherein said converting step also converts messages from said CSTA device to SIP/SIMPLE messages for a SIP device, said mapping step further maps said IM identity of said second client to said second digital telephone set and said communicating step further includes communicating an instant message between said first and said second digital telephone sets, said SIP proxy server and back, said internetworking unit converting said SIP messages back to SCTA messages (paragraph 22, where SIP may be utilized, also paragraph 23, where the other device utilizes CSTA and PBX, and where the

translator may translate from PBX and CSTA, also paragraph 53, where the converters translate between IP-PBX protocol and SIP protocol in either direction).

21. As per claim 18, Wengrovitz further teaches at least one key button is a programmable key, said method further comprising the step of configuring said at least one key button as an Instant Messaging (IM) key for a digital telephone set (Figure 1, telephone set 30, also paragraph 21, where the telephone may include a keypad and function buttons).

22. As per claim 19, Wengrovitz further teaches establishing the IM connection by pressing said instant messaging key (paragraph 21, where the telephone may include a keypad and function buttons).

23. As per claim 20, Wengrovitz further teaches sending a notification to said digital telephone set when a new instant message arrives, said digital telephone set displaying a new instant message notification in response (paragraph 34, where the unconsulted messages may be displayed and accessed by the user).

24. As per claim 21, Wengrovitz further teaches instant messaging is accomplished while the digital telephone set is off-hook (paragraph 32, where the message may be delivered while the device is off-hook).

25. As per claim 22, Wengrovitz further teaches composing and displaying instant messages using the standard key buttons and display space of said digital telephone set (Figure 1, telephone set 30, also paragraph 21, where the telephone may include a display, keypad, and function buttons).

26. As per claim 23, Carey further teaches instant messaging includes sending a notification to said digital telephone set when a request to add said digital telephone set client to the contact list of another instant messaging client is received (column 4, lines 6-33, where the user may create an instant messaging name list).
27. As per claim 24, Wengrovitz further teaches using said digital telephone set to sign-in and sign-out for instant messaging services (paragraphs 25-27, where the messaging server contains information regarding senders and recipients of messages and their extensions).
28. As per claim 25, Carey further teaches instant messaging includes using said digital telephone set to change the on-line and off-line status of said digital telephone set (column 5, lines 58-62, where the recipient is determined to be on or off-line).
29. As per claim 26, Carey further teaches communicating includes using said digital telephone set to query the status of a contact list member (column 5, lines 58-62, where the recipient is determined to be on or off-line).
30. As per claim 27, Carey further teaches communicating includes determining the presence status of said digital telephone based on call activity of said digital telephone (column 5, lines 58-62, where the recipient is determined to be on or off-line).
31. Claims 32-46 list all the same elements of claims 1-5, 7-11, and 14-18, but in method form rather than system form. Therefore, the supporting rationale of the rejection to claims 1-5, 7-11, and 14-18 applies equally as well to claims 32-46.

32. Claims rejected under 35 U.S.C. 103(a) as being unpatentable over US 2003/0021397, Wengrovitz, US 2009/0125591, Kirkpatrick, and US 6 714 793, Carey et al as applied to claims above, and further in view of US 2005/0013421, Chavez et al.

33. As per claim 28, Wengrovitz does not explicitly teach: instant messaging includes sending stored common replies to other instant messaging clients. In the same field of endeavor, Chavez teaches, (paragraph 86) the message is saved and then sent as a response.

It would have been obvious to one of ordinary skill in the networking art at the time the applicant's invention was made to combine Chavez's teachings of usage of the keys and the display of the phone to compose the instant message and full IM capability with the teachings of Wengrovitz, for the purpose of enabling a circuit switched communication device such as a telephone, to receive and respond to electronic messages (see Chavez, abstract, lines 2-4). Wengrovitz provides motivation to do so, by converting messages that adhere to a private, vendor-specific protocol, to messages that adhere to the SIP protocol (see Wengrovitz, abstract, lines 10-12).

34. As per claim 29, Wengrovitz does not explicitly teach: at least one of said stored common replies includes at least one custom data field. 62 In the same field of endeavor, Chavez teaches, (paragraph 86) the stored text message is a text response created by the user.

It would have been obvious to one of ordinary skill in the networking art at the time the applicant's invention was made to combine Chavez's teachings of usage of the keys and the display of the phone to compose the instant message and full IM capability with

the teachings of Wengrovitz, for the purpose of enabling a circuit switched communication device such as a telephone, to receive and respond to electronic messages (see Chavez, abstract, lines 2-4). Wengrovitz provides motivation to do so, by converting messages that adhere to a private, vendor-specific protocol, to messages that adhere to the SIP protocol (see Wengrovitz, abstract, lines 10-12).

35. As per claim 30, Wengrovitz does not explicitly teach: instant messaging includes sending stored common messages to other instant messaging clients. In the same field of endeavor, Chavez teaches, (paragraphs 87-88) the stored text message is transmitted in response to the sender.

It would have been obvious to one of ordinary skill in the networking art at the time the applicant's invention was made to combine Chavez's teachings of usage of the keys and the display of the phone to compose the instant message and full IM capability with the teachings of Wengrovitz, for the purpose of enabling a circuit switched communication device such as a telephone, to receive and respond to electronic messages (see Chavez, abstract, lines 2-4). Wengrovitz provides motivation to do so, by converting messages that adhere to a private, vendor-specific protocol, to messages that adhere to the SIP protocol (see Wengrovitz, abstract, lines 10-12).

36. As per claim 31, Wengrovitz does not explicitly teach: at least one of said stored common replies includes at least one custom data field. 68. In the same field .of endeavor, Chavez teaches, (paragraph 22) stored text messages are associated or mapped to keys, these messages can be customized by the user.



It would have been obvious to one of ordinary skill in the networking art at the time the applicant's invention was made to combine Chavez's teachings of usage of the keys and the display of the phone to compose the instant message and full IM capability with the teachings of Wengrovitz, for the purpose of enabling a circuit switched communication device such as a telephone, to receive and respond to electronic messages (see Chavez, abstract, lines 2-4). Wengrovitz provides motivation to do so, by converting messages that adhere to a private, vendor-specific protocol, to messages that adhere to the SIP protocol (see Wengrovitz, abstract, lines 10-12).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to THOMAS RICHARDSON whose telephone number is (571) 270-1191. The examiner can normally be reached on Monday through Thursday, 11am-6pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on (571) 272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TR  
/William C. Vaughn, Jr./  
Supervisory Patent Examiner, Art Unit 2444/